

REMARKS

Drawings

Submitted herewith, responsive to Examiner's request, please find new figures 9a, 9b and 10.

Claim Objections

It is applicant's conviction that a claim for a luminous panel with a housing as recited further limits the independent claim directed towards a luminous panel without the housing. Applicant has not amended claim 19, but alternatively requests that the matter be taken up in the requested interview if any misunderstanding remains.

35 USC §102

As is clear from the luminance distribution L along the lines a and b as in FIG. 4b, 6b and 8b, the lateral distance from the luminous-element chips 4 to the respective edge walls has a substantial effect on the shape of a luminance gradient G. A luminance gradient G' in the region of the edge wall (7', 25' or 32') is relatively large, that is, the luminance distribution has a steep ascent in this region, so that in combination with the optical element 2 a relatively sharp light/dark boundary LDB can be obtained. The other transitions in the regions of the edge wall (7'', 25'' or 32'') have a smaller luminance gradient G''. These characteristics are not known from Biebl et al.

Moreover, the Biebl reference does not disclose an optical element having a focal plane. Finally, the Biebl reference does not disclose a lens or a lens having a focal plane.

Amendment to the Claims

The amendments to the claims are supported by original specification at claim 6 and in the paragraphs 23, 27, 28 and 30.

35 USC §103

When an invention is alleged to embody old elements, it is nevertheless not obvious if those elements in the pending claims are directed towards solving a problem that is different from the problem addressed by the prior art. *See, Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 73 F2d 1452, 221 USPQ 481 (Fed. Cir. 1984). This long standing legal principle is reinforced in *KSR v. Teleflex*, 550 US1 (2007) (holding that a claimed invention may be obvious wherein its elements perform the same functions as those elements performed in the prior art, and non-obvious where old elements in the claims under consideration are used to solve different problems than they did in the prior art.)

The Biebl reference expressly states that the purpose of its structure is to dissipate heat, *see*, title. This is a different problem than that expressly called out, solved and claimed in the present application. As stated above, the present application calls out that creating a light dark boundary in a light distribution is a first problem to be solved. These

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problems being different, the Biebl reference can not suggest, motivate or otherwise render obvious the structure recited in the presently pending claims.

Moreover, it has long been the law that the discovery of a problem in prior art devices suggests non-obviousness in its solution, even though the device solving the discovered problem may appear simple in hindsight.

“[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the subject matter as a whole that should always be considered in determining the obviousness of an invention under 35 USC §103,” *See, In re Nomiya*, 509 F.2d 566, 184 USPQ 607, 612 (C.C.P.A. 1975).

“It is established law that the difficulty encountered in discovering the defects of existing devices may be taken into consideration in determining the question of invention where the defect has been remedied.” *See, In re Atkinson*, 102 F.2d 882, 41 USPQ 308, 311 (C.C.P.A. 1939). *See also, in accord, Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ 2d 1593, 1600 (Fed. Cir. 1987) (holding that a new combination was a patentable invention although it combined old elements).

Control of headlight light dark boundaries is addressed in the pending claims. The prior art did not achieve this, and in point of fact embodies exactly the sort of uncontrolled light dark boundary problem the present invention overcomes. The present

applicant has solved a problem and claimed that structure, *inter alia*, specifically overcomes that problem. Accordingly, a prior art reference embodying a prior problem cannot be properly cited in support of an obviousness rejection.

Moreover, even assuming (without conceding) that the prior art Biebl reference has enabled the creation of a light/dark boundary as claimed, the reference falls short of placing the creation of light/dark boundaries as claimed in the public domain. The reference fails the written description requirement under 35 U.S.C. § 112(1). The Biebl reference in no way demonstrates any possession by Biebl, or anyone else, of the invention presently claimed. Any light dark boundaries that may be generated by the Biebl device are mere artifact. It has long been clear that subject matter can be enabled by a prior art reference and yet not be adequately described by it to qualify as an applicable prior art reference under 35 U.S.C. § 102. The case of In re Ruschig, 343 F.2d, 965 (C.C.P.A. 1965) established that a generic disclosure is insufficient demonstration of possession of a particular species to qualify as invalidating prior art. There, a generic disclosure of a genus of chemical compounds, the synthesis of each of which would have been enabled by the prior art disclosure, was nonetheless found not to adequately describe a later claimed species within the genus under 35 U.S.C. § 102. The Federal Circuit has now made clear that a generic disclosure in the prior art which presumably enables the synthesis of each and every member of the genus, may nonetheless may not even render obvious certain compounds encompassed by that generic disclosure. In re Baird, 16 F.2d, 380, 382 (Fed. Cir. 1994). The requirement is

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no less stringent in mechanical cases, see In re Barker, 559 F.2d, 588 (C.C.P.A. 1977)
and see Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473 (Fed. Cir. 1998).

Because the Biebl reference fails to describe in writing the structure presently claimed in sufficient detail to put possession of the claimed structure in the public domain, the reference cannot qualify as prior art and cannot render the present claims obvious.

Accordingly, the claims should be allowed in their present form.

Interview Requested

Applicant requests an interview.

Respectfully submitted,



By: Robert C. Haldiman, Reg. No. 45,437
Husch Blackwell Sanders LLC
190 Carondelet Plaza
St. Louis, MO 63105
314-480-1641
314-480-1505 FAX